

DOCKET NO: 217567US



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
HUGH J. ABERCROMBIE : EXAMINER: WYSZOMIERSKI, G.  
SERIAL NO: 10/021,063 :  
FILED: DECEMBER 19, 2001 : GROUP ART UNIT: 1742  
FOR: RECOVERY OF NATURAL :  
NANOCLUSTERS AND THE  
NANOCLUSTERS ISOLATED THEREBY

RECEIVED  
JAN 07 2004  
TC 1700

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In Response to the Official Action dated June 25, 2003, and accompanied by a petition for a five-month extension of time and the appropriate fees, Applicants elect, with traverse, Group II, Claims 65-81, for prosecution in the present application. Applicants further provisionally elect, with traverse, species comprising compositions based upon at least one of Au, Ag or the platinum group metals, for examination purposes only. Claims 65-69, 71, 73, 74-77, 79 and 81 read on the elected species. Applicants also provide herewith a new Power of Attorney granting the undersigned power to prosecute the present application.

REMARKS

The Examiner has required restriction between the following:

Group I: Claim 1

Group II: Claims 65-81.

Applicants elect with traverse, Group I, Claims 65-81 for prosecution in the present application. The Examiner has classified the groups as Process of making and Product made. Citing MPEP 806.05(f), the Examiner states that the groups are patentably distinct as the product as claimed can be made by a materially different process, namely by naturally occurring processes. However, Applicants note that the claims of Group II all relate to an isolated naturally occurring nanocluster, which inherently requires some process be present to isolate the nanocluster. Applicant is aware of no naturally occurring processes that can effect this isolation. Accordingly, the Examiner has not provided sufficient reasons to support a conclusion of patentable distinctness.

Applicants have provisionally elected, for search and examination purposes only, the following species;

Compositions based upon (i.e. comprising) one or more metals selected from Au, Ag and the platinum group metals.

With respect to the elected species, Applicants respectfully submit that should the elected species be found allowable, the Office should expand its search to the non-elected species.

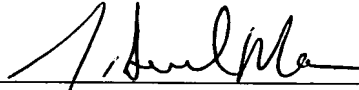
Application No. 10/021,063 .

• Reply to Office Action of June 25, 2003

Applicants respectfully submit that the above-identified application is now in  
condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

J. Derek Mason, Ph.D.

Attorney of Record

Registration No. 35,270

Customer Number

**22850**

Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 08/03)